

ESTTA Tracking number: **ESTTA573254**

Filing date: **11/26/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	T & C Nederland B.V.
Granted to Date of previous extension	11/27/2013
Address	Silodam 187 Amsterdam, 1013 NETHERLANDS
Attorney information	Julia C. Archer Enns & Archer LLP 939 Burke Street Winston-Salem, NC 27101 UNITED STATES jarcher@ennsandarcher.com Phone:336-723-5180

### Applicant Information

Application No	85852036	Publication date	07/30/2013
Opposition Filing Date	11/26/2013	Opposition Period Ends	11/27/2013
Applicant	Shirley, Stephanie Rose 6138 Franklin Ave Suite 314 Hollywood, CA 90028 USX		

### Goods/Services Affected by Opposition

Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Baby backpacks; Backpacks, book bags, sports bags, bum bags, wallets and handbags; Schoolchildren's backpacks
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Hats for infants, babies, toddlers and children

### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1806173	Application Date	02/26/1990
Registration Date	11/23/1993	Foreign Priority	NONE

		Date	
Word Mark	TARTINE ET CHOCOLAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1979/01/00 First Use In Commerce: 1979/01/00 baby's and children's clothing; namely,overalls, shorts, Bermuda shorts, jackets, sleeveless jackets, cardigans, pullovers, sweat-shirts, coats, pullover-trouser sets, sleep suits, tracksuit, ponchotrouser sets, one-piece vest, sleeved west, shirts, T-shirt, frocks, poncho aprons, pajamas, night shirts, night gowns,dressing gowns, bathing wraps, tights, mitts and bibs, peignoirs, babies' clothdiapers, layette, romper		

U.S. Registration No.	2185508	Application Date	03/12/1997
Registration Date	09/01/1998	Foreign Priority Date	NONE
Word Mark	TARTINE ET CHOCOLAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1986/00/00 First Use In Commerce: 1986/00/00 fluffy toys, namely, teddy bears, fluffy animals, fluffy dolls, dolls, doll's clothes, doll's houses, rattles, namely, toy rattles, infant rattles, baby rattles, marionette puppets		

U.S. Registration No.	3135999	Application Date	12/29/2004
Registration Date	08/29/2006	Foreign Priority Date	NONE
Word Mark	TARTINE ET CHOCOLAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Spectacles, sunglasses, spectacle frames, spectacle cases		

Attachments	75256329#TMSN.gif( bytes ) 79011224#TMSN.jpeg( bytes ) Notice of Opposition HOT CHOCOLATE AND TOAST CLOTHING COMPANY.pdf(17739 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/jarcher/
Name	Julia C. Archer
Date	11/26/2013

**In the matter of U.S. Trademark Application Serial No. 85852036**  
**Published in the *Official Gazette* on July 30, 2013**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**T & C NEDERLAND B.V.,**

**Opposer,**

**v.**

**Opposition No. \_\_\_\_\_**

**STEPHANIE ROSE SHIRLEY,**

**Applicant.**

**NOTICE OF OPPOSITION**

Opposer T & C Nederland B.V., a Besloten Vennootschap (limited liability company) organized under the laws of The Netherlands, with offices at Silodam 187, NL-1013 AS Amsterdam, NETHERLANDS (“T&C”), believes that it will be damaged by registration to Applicant Stephanie Rose Shirley of the trademark shown in U.S. Trademark Application Serial No. 85852036, published in the Official Gazette on July 30, 2013, and hereby opposes the same. T&C requested and was granted an extension of time to oppose this application until November 27, 2013. As grounds for this opposition, T&C alleges the following:

1. T&C is the owner of three active registrations in the United States for the mark TARTINE ET CHOCOLAT in both standard character and design or stylized format. These registrations are (1) U.S. Trademark Registration No. 1806173 for the word mark TARTINE ET CHOCOLAT for “baby's and children's clothing; namely, overalls, shorts, Bermuda shorts,

jackets, sleeveless jackets, cardigans, pullovers, sweat-shirts, coats, pullover-trouser sets, sleep suits, tracksuit, poncho trouser sets, one-piece vest, sleeved west, shirts, T-shirt, frocks, poncho aprons, pajamas, night shirts, night gowns, dressing gowns, bathing wraps, tights, mitts and bibs, peignoirs, babies' cloth diapers, layette, romper,” having a date of first use and of first use in commerce of January 1979; (2) U.S. Registration No. 2185508 for the mark TARTINE ET CHOCOLAT & Design for “fluffy toys, namely, teddy bears, fluffy animals, fluffy dolls, dolls, doll's clothes, doll's houses, rattles, namely, toy rattles, infant rattles, baby rattles, marionette puppets,” having a date of first use and of first use in commerce of 1986; and (3) U.S. Registration No. 3135999 for the mark TARTINE ET CHOCOLAT (stylized) for “Spectacles, sunglasses, spectacle frames, spectacle cases” (collectively the “TARTINE ET CHOCOLAT Mark”). Each of these registrations is valid, subsisting and uncanceled, and has become incontestable pursuant to the provisions of Lanham Act Section 15, 15 U.S.C. § 1065.

2. In addition, over the years, T&C has expanded its use of the TARTINE ET CHOCOLAT Mark beyond children's clothing and toys to include nursery furniture and bedding, rugs, fragrances, and other baby gifts.

3. From the dates of first use through the present, T&C and its predecessors and licensees have continuously promoted and advertised the children's clothing, toys and other products offered under the TARTINE ET CHOCOLAT Mark throughout the United States. Products bearing the TARTINE ET CHOCOLAT Mark are sold by Neiman Marcus, Saks Fifth Avenue, Bloomingdale's, and other fine retailers. As a result, the TARTINE ET CHOCOLAT Mark has become well-known and widely recognized among the consuming public as symbolizing the high quality of the goods to which it is applied.

4. As a result of the foregoing advertising and promotion for more than 30 years and the high quality of the goods to which the Mark has been applied, T&C's TARTINE ET CHOCOLAT Mark has become a means by which T&C's products are distinguished by the consuming public from the products of others. By virtue of the advertising and promotional activities of T&C's predecessors, licensees and vendors, and the high quality of T&C's products, T&C has obtained and now enjoys an exceedingly valuable reputation, goodwill, and trust symbolized by the TARTINE ET CHOCOLAT Mark, and it is recognized by the relevant purchasing public as a designation of source of T&C's goods.

5. By filing the pending application, Serial No. 85852036, on an intent to use basis, Applicant seeks to register the standard-character mark HOT CHOCOLATE AND TOAST CLOTHING COMPANY ("Applicant's Mark") on the Principal Register for use on "Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Hats for infants, babies, toddlers and children" and on "Baby backpacks; Backpacks, book bags, sports bags, bum bags, wallets and handbags; Schoolchildren's backpacks" (collectively, "Applicant's Goods").

6. Applicant's Mark is highly similar to T&C's registered and incontestable TARTINE ET CHOCOLAT Mark that has been continuously used throughout the U.S. in connection with children's clothing since at least 1979, and in connection with other children's items over the years. The TARTINE ET CHOCOLAT mark translates from the French into "a slice of bread and chocolate." Pursuant to the doctrine of foreign equivalents, a foreign word or phrase and its English equivalent may be held to be confusingly similar. Applicant's HOT CHOCOLATE AND TOAST CLOTHING COMPANY mark is essentially the English translation of T&C's TARTINE ET CHOCOLAT Mark. The addition of the descriptive

wording “Clothing Company” in Applicant’s Mark does not distinguish the two marks, but actually increases the likelihood of confusion due to the reputation and goodwill built up by T&C in the TARTINE ET CHOCOLAT Mark in connection with children’s clothing and accessories during the last 30+ years.

7. The clothing for babies, toddlers and children recited in Applicant’s HOT CHOCOLATE AND TOAST CLOTHING COMPANY application are identical to the goods with which T&C uses the TARTINE ET CHOCOLAT Mark. The baby backpacks and other bags recited in the application are sufficiently related to children’s clothing and toys to give rise to a likelihood of confusion as to the source or sponsorship of the goods. Applicant’s Goods are of a type that are frequently manufactured, marketed and sold under the same mark to the same or similar consumers through the same or similar channels of trade as children’s clothing, toys and the other items offered in connection with T&C’s TARTINE ET CHOCOLAT Mark. Consumers are likely to mistakenly assume that T&C has expanded its mark to include the backpacks and bags, or has otherwise authorized or sponsored those goods.

8. Under all the circumstances, Applicant’s Mark, when used in connection with Applicant’s Goods as identified in the subject application, so resembles T&C’s previously used and registered TARTINE ET CHOCOLAT Mark as to be likely to cause confusion, to cause mistake, and/or to deceive actual and prospective purchasers concerning an affiliation, connection, association or sponsorship with T&C as the source of goods featuring T&C’s TARTINE ET CHOCOLAT Mark, in violation of Sections 2(d) and 43(a) of the Lanham Act, 15 U.S.C. §§ 1052(d) and 1125(a), with consequent injury to T&C and the consuming public.

9. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), T&C believes it will be damaged by registration of Applicant’s Mark in that actual and prospective purchasers

and users are likely to be confused or mistaken that Applicant's Goods offered under Applicant's Mark originate from T&C, or from the same source as goods featuring T&C's TARTINE ET CHOCOLAT Mark, or that such goods of Applicant are sponsored by, endorsed by, or affiliated with the source of goods bearing T&C's marks. Registration of Applicant's Mark will support and assist Applicant in the confusing and misleading use of Applicant's Mark, and will give color of exclusive statutory right to Applicant in violation and derogation of prior and superior rights of T&C.

WHEREFORE, T&C prays that registration of Applicant's Mark, as shown in Application Serial No. 85852036, not be allowed.

This Notice of Opposition is being filed through the ESTTA system and the fee for this proceeding in the amount of \$600 is being charged to Deposit Account No. 501779. Please recognize the undersigned Julia C. Archer and Rodrick J. Enns as attorneys for T&C in connection with this opposition proceeding, and address all correspondence regarding this proceeding as shown below.

Respectfully submitted,

Dated: November 26, 2013

/ Julia C. Archer/  
Julia C. Archer  
Rodrick J. Enns  
Attorneys for Opposer T & C Nederland B.V.

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**CERTIFICATE OF SERVICE**

I hereby certify that on this date I served the foregoing NOTICE OF OPPOSITION upon Applicant by depositing a copy thereof with the United States Postal Service, first-class postage prepaid, and addressed to Applicant at its correspondence address of record in the U.S.

Trademark Office:

Ms. Stephanie Shirley  
Hot Chocolate and Toast Clothing Company  
6138 Franklin Ave, Suite 314  
Hollywood, CA 90028

This the 26th day of November, 2013.

/Julia C. Archer/

Julia C. Archer

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